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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,272	09/25/2006	Petrus Johannes Lenoir	NL 040315	6405

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EXAMINER

KING, JOHN B

ART UNIT	PAPER NUMBER
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2435

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06/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,272	Applicant(s) LENOIR ET AL.	
	Examiner John B. King	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The instant application having Application No. 10/599272 filed on September 25, 2006 is presented for examination by the examiner.
2. Claims 1-32 have been canceled and claims 33-60 have been added by preliminary amendment.

Oath/Declaration

3. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

Information Disclosure Statement

4. As required by **M.P.E.P. 609(C)**, the applicant's submissions of the Information Disclosure Statement dated 5/10/2007 is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending. As required by **M.P.E.P. 609(C)**, a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

Drawings

5. The applicant's drawings submitted are acceptable for examination purposes.

Priority

6. As required by **M.P.E.P. 201.14(c)**, acknowledgement is made of applicant's claim for priority based on applications filed on March 26, 2004 (EP 04101256.8).

Examiner Notes

7. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 47-59** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claims 47-59 recite many instances of using the phrase "means for" or "step for", but it is modified by some structure, material, or acts recited in the claim. It is unclear

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whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

If applicant wishes to have the claim limitations treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claims so that the phrase "means for" or "step for" is clearly not modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does not wish to have the claim limitations treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for" or "step for").

11. The examiner has cited particular examples of 35 U.S.C. 112 rejections above. It is respectfully requested that, in preparing responses, the applicant check the claims for further 35 U.S.C. 112 rejections as being indefinite in case it was inadvertently missed by the examiner. The following prior art rejections are based upon the examiner's best interpretation of the claims.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. **Claim 30** is rejected under 35 U.S.C. 101 as directed to non-statutory subject matter of software, *per se*. The claim lacks the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. 101. It is clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. It is at best, function descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. **Claims 33-35, 37-49, and 51-60** are rejected under 35 U.S.C. 102(b) as being anticipated by Nakahara et al. (US Pre-Grant Publication 2003/0018491 A1, published January 23, 2003) hereinafter referred to as Nakahara.

As per claim 33, 47, and 60, Nakahara discloses A method and system of generating an Authorized Domain (AD), comprising: selecting a domain identifier uniquely identifying the Authorized Domain (**Nakahara, paragraph 200, teaches having a domain list that identifies the authorized devices.**); binding at least one user to the domain identifier (**Nakahara, paragraph 200, teaches searcher X being a user.**); and binding at least one device to at least one user by obtaining or generating a Device Owner List comprising a unique identifier for a user and a unique identifier for each device belonging to the user, thereby defining that the at least one device is bound to the user (**Nakahara, paragraph 200, teaches the authorized devices being on the domain list.**), or in that the binding of at least one device to at least one user comprises obtaining or generating a Device Owner List for each device to be bound, the Device

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Owner List comprising a unique identifier for a user and a unique identifier for a device belonging to the user, thereby defining that the device is bound to the user, thereby obtaining a number of devices and a number of users that is authorized to access a content item of said Authorized Domain **(Nakahara, paragraph 200, teaches having a domain list that contains the authorized devices that belong to that user's domain.)**

As per claims 34 and 48, Nakahara discloses wherein each device may be bound to only a single user, or each device may be bound to several users, where one user is indicated as a primary user for that particular device **(Nakahara, paragraph 226, teaches having user IDs associated with the authorized devices. Therefore, one or more users may be associated with a particular device.)**

As per claims 35 and 49, Nakahara discloses further comprising importing, on a given device, at least one content item into the Authorized Domain given by the domain identifier by automatically binding, by default, the at least one imported content item to the single user that the given device is bound to or to the user indicated as primary user for the given device, or binding the at least one imported content item to another user using additional information, when non-default binding is to be used **(Nakahara, paragraph 197, teaches having content that only particular users/devices can have access to.)**

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As per claims 37 and 51, Nakahara discloses further comprising using at least one of a user identification device as a personal Authorized Domain manager, a personal mobile device as a personal Authorized Domain manager, a mobile phone as a personal Authorized Domain manager, a PDA (personal digital assistant) as a personal Authorized Domain manager **(Nakahara, paragraph 297-298, teaches the user having an IC card containing the PIN to be used with the content usage device. This device will manage whether or not the user has access to content.)**

As per claims 38 and 52, Nakahara discloses wherein the binding of at least one user to the domain identifier comprises obtaining or generating a Domain Users List comprising the domain identifier and a unique identifier for a user thereby defining that the user is bound to the Authorized Domain **(Nakahara, paragraph 297, teaches a user having a PIN for authentication.)**

As per claims 39 and 53, Nakahara discloses wherein the binding of at least one content item to the Authorized Domain comprises binding a content item to a User Right, where said User Right is bound to a user bound to the Authorized Domain **(Nakahara, paragraph 297, teaches the content being associated with a particular user through the users PIN.)**

As per claims 40 and 54, Nakahara discloses wherein the User Right comprises rights data representing which rights exists in relation to the at least one content item

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bound to the User Right (**Nakahara, paragraph 297, teaches the user purchasing a license for the content. A license inherently grants the user the rights that he/she has paid for and that the copyright holder will allow. Paragraph 63 teaches different access rights for content.**)

As per claims 41 and 55, Nakahara discloses further comprising controlling access, by a given device being operated by a given user, to a given content item comprising checking whether a user, the given content item is linked to, and a user, the given device is linked to, belongs to the same Authorized Domain, and allowing access for the given user and/or other users via the given device to the content item if so, and/or checking if the given content item is linked to a user belonging to the same Authorized Domain as the given user, and allowing access for the given user via the given device and/or other devices to the content item if so (**Nakahara, paragraphs 194-197, teaches only granting access to the content if the device is authorized and the user is granted access to the content through the usage restriction.**)

As per claims 42 and 56, Nakahara discloses further comprising controlling access, by a given device being operated by a given user, to a given content item being bound to the Authorized Domain and having a unique content identifier, comprising checking if the Domain User List of the Authorized Domain comprises both a first user identifier, comprised in a Device Owner List comprising an identifier of the given device, and a second user identifier, linked to the given content item, thereby checking if the

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user bound to the given device is bound to the same Authorized Domain as the user bound to the content item, and allowing access to the given content item by the given device operated by any user and/or checking if the Domain User List of the Authorized Domain, that the content item is bound to, comprises a user identifier of the given user thereby checking if the given user is bound to the same Authorized Domain as the content item, and allowing access to the given content item by any device including the given device operated by the given user **(Nakahara, paragraphs 194-197, teaches granting or restricting access to content based on whether user and device authorization requirements are met.)**

As per claims 43 and 57, Nakahara discloses wherein the controlling of access of a given content item comprises checking that the User Right for the given content item specifies that the given user has the right to access the given content item and only allowing access to the given content item in the affirmative **(Nakahara, paragraph 63, teaches the license information containing information about the usage rights that the user has for the content.)**

As per claims 44 and 58, discloses wherein every content item is encrypted and that a content right is bound to each content item and to a User Right, and that the content right of a given content item comprises a decryption key for decrypting the given content item **(Nakahara, paragraphs 48-50, teaches content encryption and decryption keys.)**

As per claims 45 and 59, discloses wherein the Domain Users List is implemented as or included in a Domain Users Certificate, and/or the Device Owner List is implemented as or included in a Device Owner Certificate, and/or the User Right is implemented as or included in a User Right Certificate **(Nakahara, paragraphs 198, 249-251, and 258, teaches license authentication being included in certificates.)**

As per claim 46, discloses further comprising binding at least one content item to at least one user **(Nakahara, paragraphs 194-197, teaches usage restrictions for users. Certain content is only available to certain users.)**

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 36 and 50** as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahara.

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As per claims 36 and 50, Nakahara does not specifically teach limiting the number of users.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an Authorized Domain size limitation, where the limitation relates to a maximum number of users. It is well known in the art to limit the number of users that can have access to copy protected content. This usually limits the number of users to one user at a time, but can be multiple users at the same time.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. King whose telephone number is (571)270-7310. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 4:00 PM est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JBK/

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435